

ATTORNEY DOCKET NO. 25006.0016U2
Application No. 10/669,162

In response, applicants elect Group I, claims 1-7, with traverse. The Office Action also required that if any of claims 6 or 12-17 were elected, that one riboswitch or structure also be elected. In response, applicants elect guanine-responsive riboswitches with traverse.

Applicant respectfully requests that the restriction requirement be reconsidered, as the Examiner has not shown that a serious burden would result if all the claims are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the “groups” would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement.

Applicant also respectfully requests that the requirement for species election be reconsidered, as the Examiner has not shown that a serious burden would result if all the species are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See*

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M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the “species” would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement. In addition, as each of the species listed in claims 6 and 12-17 properly fall within the elected genus (see above), Applicant reminds the Examiner that if the elected genus is found to be allowable, all of the species listed in claims 6 and 12-17 should also be found allowable.

The Office Action states that the claims of Groups I and II-III are related as product and process of use and are distinct because the products as claimed can be used in a materially different process, such as in detection or diagnosis. The MPEP § 821.04 states that where an applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined as a matter of right, so long as the process claims that depend from or otherwise include all the limitations of the patentable product. Applicants, by choosing the product claims of Group I, and because the product claims of Group I include all the limitations of the claims of Group II-III, hereby remind the Examiner that Groups II and III should be rejoined upon allowance of the claims of Group I.

Favorable consideration of claims 1-19 is earnestly solicited.

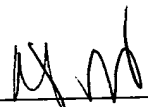
A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$1080.00, representing the fee for a small entity under 37 C.F.R. § 1.17(a)(5), and a Request For Extension of Time are enclosed. This amount is believed to be correct; however, the Commissioner is

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hereby authorized to charge any additional fees which may be required, or credit any
overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

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Robert A. Hodges

10/19/2006

Date